

REMARKS

Claims 1-40 are pending, in which no claim is canceled, withdrawn, currently amended, or newly presented.

Claims 1, 5 through 9, 13 through 17, 21 through 25, 29 through 33, and 37 through 40 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Cox et al. in view of Gerszberg et al. and BOC.

This rejection is traversed. Applicants submit that the Examiner did not establish a *prima facie* basis to deny patentability to any of the claimed inventions. In order to simplify the issues, Applicants will refer to exemplary claim 1, since the features of claim 1 distinguishing over the applied prior art also appear in each of the independent claims.

Claim 1 recites the following:

1. A method of charging for directory assistance services that are provided over a packet switched network, the method comprising:
transmitting information associated with a plurality of directory listings to a client access device over the packet switched network in response to a query initiated by a customer;
in response to a selection of more than one of the directory listings from the client access device, transmitting a plurality of listing numbers to the client access device; and
preparing billing information based upon a number of the plurality of listing numbers transmitted to the client access device.

No such method, server, service system, or computer readable program embodying these features is disclosed or suggested by the applied prior art, considered singly or in combination. **Applicants stress that the applied prior art neither discloses nor suggests the concept of transmitting a plurality of listing numbers to a client access device in response to the**

selection of more than one of the directory listings which were supplied as a consequence of a customer initiated query.

Undisputed Facts.

There is **no dispute**, and the Examiner **admitted**, that the reference to Cox et al. fails to teach transmitting information associated with one or more directory listings to a client access device over a package switch network in response to a query.

Applicants have argued throughout prosecution that Cox et al. do not disclose the concept of transmitting a plurality of listing numbers to the client access device in response to a selection of more than one of directory listings from the client access device. That fact is **not disputed** on its record. *In re Clinton*, 527 F.2d 1226, 188 USPQ 365 (CCPA 1976).

Applicants also argued that in accordance with the system disclosed by Cox et al., directory assistance services and billing services are **divorced** from one another, thereby making it the cellular carrier's responsibility to rate the calls and determine what charge is to be levied, **not the provider of the directory assistance service**. That fact is **not disputed**. *In re Clinton*, *supra*.

Throughout prosecution Applicants also argued that the Examiner's proposed modification of Cox et al. undermines the entire objective of Cox et al., because it would make the directory assistance service provider assume the responsibilities rather than the cellular carriers responsibility. Interestingly enough, the Examiner has **not disputed** that fact. *In re Clinton*, *supra*.

The Examiner's Conclusion.

Notwithstanding the above **undisputed facts**, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify (actually undermine) the system of Cox et al. by applying the teachings of Gerszberg et al. It is difficult to discern from the Examiner's explanation precisely how that combination is proposed to be effected. At any rate, still not there, recognizing the failure to disclose a plurality of listings and charging for the plurality of listings, the Examiner turns to BOC. The Examiner then concluded that one having ordinary skill in the art would have been motivated to combine all three references, again not bothering to favor the record with precisely how the references are to be combined.

There Is No Motivation.

In order to establish the requisite realistic motivation, the Examiner is required to make **clear and particular factual** findings as to a specific understanding or specific technological principle and then, based upon such **facts**, explain **why**, one having ordinary skill in the art would have been **realistically** motivated to modify **particular prior art**, in this case the particular system disclosed by Cox et al., to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *Ecolochem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). Moreover, the requisite fact-based motivation must be undertaken with a reasonable expectation of **successfully achieving** some particular objective. *Velander v. Garner*, 348 F.3d 1359, 68 USPQ2d 1769 (Fed. Cir. 2003); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants would stress that generalizations do not suffice. Rather, the Examiner must explain why one having ordinary skill in the art would have been realistically motivated to modify a

particular reference in a **particular** manner to arrive at a **particular** claimed invention. *Ecolochem Inc. v. Southern California Edison, Co., supra; In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d 1453 (Fed. Cir. 1998).

In applying the above legal tenets to the exigencies of this case, Applicants submit that the Examiner failed to establish a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite factual basis and want of the requisite realistic motivation.

Firstly, the **Examiner's reason** for attempting to combine Gerszberg et al. with Cox et al. is "... to give the user more control of how and what information they are receiving from the service" (page 3 of the November 30, 2006 Final Office Action, lines 4 and 5). **Where is that in the applied prior art?**

The Examiner should be made aware that regardless of what is perceived as the source of motivation, the Examiner must still provide factual support. See, for example, *Teleflex Inc. v. Ficoso North America Corp.*, [299 F.3d 1313], 63 USPQ2d 1374, 1387 (Fed. Cir. 2002), wherein the Court stated:

The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.

Accordingly, for starters, the Examiner simply failed to provide a factual basis to support the asserted motivation to combine, in some unexplained manner, Cox et al. and Gerszberg et al.

Applicants cannot overemphasize the undisputed fact that the Examiner's proposed modification of Cox et al. would **undermine the objective of Cox et al.** Again, it is **undisputed** on this record that the system disclosed by Cox et al. imposes the responsibility to rate the calls and determine the charge to be levied upon the **cellular carrier**. It is also

undisputed on the record that the Examiner's proposed modification of Cox et al. would **undercut** that objective by making it the responsibility of the **directory assistance service provider**. It is **legally erroneous** to conclude that one having ordinary skill in the art would have been realistically motivated to modify a reference in a manner **inconsistent** with the disclosed objective. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Schulpen*, 390 F.2d 1009, 157 USPQ 52 (CCPA 1968).

The Combined Disclosures Do Not Yield the Claimed Invention.

It is not disputed on this record that Cox et al. do not disclose the notion of transmitting a plurality of listing numbers to a client access device in response to a selection of more than one of the directory listings from the client access device sent in response to a customer inquiry. That lacuna between the claimed invention and Cox et al. is not bridged by Gerszberg et al. This is because in the system of Gerszberg et al. there is no means for the directory assistance service to first receive information on which listings the customer selects and, therefore, no means of transmitting the actual listing numbers to the customer. In other words, in the system of Gerszberg et al., the listing numbers are sent directly to the customer in response to the inquiry. **However, in accordance with the claimed inventions, there is an initial transmission of information associated with the plurality of directory listings based upon a customer inquiry, and a subsequent transmission of a plurality of listing numbers in response to a selection of more than one directory listing by the customer.**

The tertiary reference to BOC does not cure the previously argued deficiencies in the attempted combination of Cox et al. and Gerszberg et al. Accordingly, even if the applied references were somehow combined, and again the Examiner has not articulated precisely how

they would be combined, and Applicants certainly do not agree that the requisite fact-based motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

The Examiner's Most Recent Exposition.

The arguments repeatedly advanced throughout prosecution have elicited another refractory position by the Examiner. Specifically, in the 16th enumerated paragraph on page 7 of the November 30, 2006 Final Office Action, the Examiner acknowledges that Cox et al. make the cellular carrier responsible for the rate of calls rather than the directory assistance service provider. The Examiner then notes that the claims do not specify who is responsible for the billing process. The Examiner's position evinces a clear misunderstanding of the argument advanced.

As mentioned above, it is undisputed on this record that Cox et al. make the cellular carrier responsible for the rate of calls, and that the Examiner's proposed modification of Cox et al. would undo that system by imposing responsibility on the directory assistance service provider. Again, it is **legally erroneous** to conclude that one having ordinary skill in the art would have been realistically motivated to modify an applied reference, *i.e.*, Cox et al., in a manner inconsistent with the undisputed disclosed objective. *In re Fritch, supra; In re Gordon, supra; In re Schulpfen, surpa.* **It matters not one whit where billing responsibility is imposed in the claims. What matters is that the Examiner is proposing to undermine the objective of Cox et al. And that is legally wrong.**

In the 17th enumerated paragraph, the Examiner acknowledges the argument that the reference (presumably Cox et al.) does not teach “in response to selection”. The Examiner then states that BOC is charging the user for several directory listings. The Examiner then states:

... it is implied that the user has previously selected the multiple listings.”

The Examiner appears to cavalierly dismiss the requirement that obviousness must be predicated upon facts, not speculation. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966). Since the Examiner’s quiver is empty of facts, he conveniently assumes facts.

The Examiner’s convenient assumption of facts does not withstand scrutiny. This is because desired numbers can be supplied when requested. That is a far cry from transmitting a plurality of listings in response to a selection of more than one of directory listings supplied in response to an inquiry. As a clear factual matter, BOC does **not** disclose transmitting a plurality of listing numbers to a client access device in response to a selection of more than one of the directory listings supplied in response to a client inquiry. Therefore, BOC cannot teach the concept of preparing billing information based upon a number of the plurality of listing numbers transmitted to the client device. No amount of wishing, assuming, or squinting at BOC can bring such a concept into focus.

It would, therefore, appear that the Examiner’s final conclusion is based upon conveniently ignoring the fact that the proposed combination of Cox et al. and Gerszberg et al. would destroy the objective of Cox et al., and the inconvenient assumption of missing facts. This is hardly compelling. Rather, the Examiner would appear to be setting a fresh standard of hindsight.

Conclusion.

Based upon the foregoing Applicants submit that the Examiner failed to establish a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite factual basis and want of the requisite realistic motivation. Applicants, therefore, submit that the imposed rejection of claims 1, 5 through 9, 13 through 17, 21 through 25, 29 through 33, and 37 through 40 under 35 U.S.C. § 103 for obviousness predicated upon Cox et al. in view of Gerszberg et al. and BOC is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 2 through 4, 10 through 12, 18 through 20, 26 through 28, and 34 through 36 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Cox et al. in view of Gerszberg et al., presumably BOC, and Shah et al.

This rejection is traversed.

Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1, 9, 17, 25, and 33 under 35 U.S.C. § 103 for obviousness predicated upon the combined disclosures of Cox et al., Gerszberg et al., and BOC. The additional reference to Shah et al. does not cure the previously argued deficiencies in the attempted combination of Cox et al., Gerszberg et al., and BOC. Accordingly, even if the applied references are combined as proposed by the Examiner, and again Applicants do not agree that the requisite fact-based motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.*

Moreover, Applicants separately argue the patentability of the dependent claims. Specifically, Applicants would stress that each of claims **2, 10, 18, 26, and 34** requires the

inclusion of **partial directory information** in the information transmitting step. That feature is neither disclosed nor suggested by any of the applied references, including Shah et al.

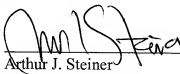
In the 18th enumerated paragraph of the November 30, 2006 Final Office Action, the Examiner accuses Applicants of failing to argue why the claims differ. Applicants have argued that the applied reference does not disclose the concept of transmitting partial directory information. The Examiner now beats a path to column 3 of Shah et al., lines 50 through 55. Applicants have reviewed column 3 of Shah et al., lines 50 through 55, and do not find any suggestion of “partial directory information.” Applicants find only a listing of information contained within a repository of billing rate information. The notion of transmitting partial directory information in the information transmitting step is not to be found.

Applicants, therefore, submit that the imposed rejection of claims 2 through 4, 10 through 12, 18 through 20, 26 through 28, and 34 through 36 under 35 U.S.C. § 103 for obviousness predicated upon Cox et al. in view of Gerszberg et al., BOC, and Shah et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9954 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

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